

9/20/01

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 17
CEW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Gillette Canada Company d/b/a Oral-B Laboratories
v.
Everapex Products, Inc.

Opposition No. 111,740
to Application No. 75/324,250
filed on July 14, 1997

Marie V. Driscoll and Michael Chiappetta of Fross,
Zelnick, Lehrman & Zissu for Gillette Canada Company
d/b/a Oral-B Laboratories.

David A. Greenlee, Esq. for Everapex Products, Inc.

Before Hairston, Walters and Bottorff, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Gillette Canada Company d/b/a Oral-B Laboratories
filed its opposition to the application of Everapex
Products, Inc. to register the mark ORAL TECH for "dental
mirrors and dental picks," in International Class 10, and
"manual, power-operated, and interdental toothbrushes,
dental floss, and dental floss picks," in International

Class 21.¹ The application includes a disclaimer of ORAL apart from the mark as a whole.

As grounds for opposition, opposer asserts that applicant's mark, when applied to applicant's goods, so resembles opposer's previously used and registered marks, ORAL-B, both in stylized and unstylized forms, for a variety of preventive dentistry products as to be likely to cause confusion, under Section 2(d) of the Trademark Act.

Applicant, in its answer, denied the salient allegations of the claim.

The record consists of the pleadings; the file of the involved application; certified status and title copies of opposer's seven registrations, noted below; and the testimony deposition by opposer of Alan A. Michaels, a vice president of opposer, with accompanying exhibits. Only opposer submitted evidence and testimony and filed a brief on the case. A hearing was not requested.

Through the testimony of Alan A. Michaels, the vice president of professional group North America for the Oral-B division of opposer, opposer has established that the trade name and trademark, ORAL-B, has been used by

¹ Application Serial No. 75/324,250, filed July 14, 1997, based upon an allegation of a bona fide intention to use the mark in commerce in connection with the identified goods.

opposer to identify its company and its products since at least 1948; and that opposer's primary dental product categories are manual toothbrushes, dental floss and power-assisted or electric toothbrushes. Mr. Michaels testified that opposer sells its products to the general consumer through all retail channels of trade for such products; and that it also sells its products to dental professionals directly, through its professional sales force, and through dental dealers who are wholesalers to the dental profession. Mr. Michaels stated that opposer's total sales of its dental products for the three-year period 1997-1999 were \$830 million, averaging \$275 million per year; and that its advertising costs for the same period were \$240 million, averaging \$80 million per year. Opposer's advertising includes print publications and publication inserts, direct mail, radio and television, and trade shows and professional conventions. The mark ORAL-B is used in all advertising, product packaging and on the products themselves. Opposer sub-brands its products so that different models of its various products include additional marks, e.g., ORAL-B ADVANTAGE, ORAL-B SATINFLOSS, ORAL-B INDICATOR, and ORAL-B RADICAL CONTROL. Mr. Michaels stated that

opposer has the number one market share in each of its product categories.

Opposer has made the following registrations of record:

No. 547,130² for the mark ORAL B in stylized script for toothbrushes;

No. 1,106,587³ for the mark ORAL-B in stylized form for dental floss dispensers and dental floss;

No. 1,197,304⁴ for the mark ORAL-B in stylized script for toothbrushes;

No. 1,501,858⁵ for the mark ORAL-B for topical flouride gels for application to the teeth, medicated mouthrinse preparations;

No. 1,502,069⁶ for the mark ORAL-B for dental floss and trays for topical application of flouride compositions and other preparations to the teeth;

²Registration No. 547,130, issued August 28, 1951, in International Class 29. [2nd renewal for a period of 10 years from August 28, 1991; Sections 8 and 15 affidavits accepted and acknowledged, respectively.]

³Registration No. 1,106,587, issued November 28, 1978, in International Class 10. [Renewed for a period of 10 years from November 21, 1998; Sections 8 and 15 affidavits accepted and acknowledged, respectively.]

⁴Registration No. 1,197,304, issued June 8, 1982, in International Class 21. [Sections 8 and 15 affidavits accepted and acknowledged, respectively.]

⁵Registration No. 1,501,858, issued August 30, 1988, in International Class 5. [Sections 8 and 15 affidavits accepted and acknowledged, respectively.]

⁶Registration No. 1,502,069, issued August 30, 1988, in International Class 10. [Sections 8 and 15 affidavits accepted and acknowledged, respectively.]

No. 1,502,752⁷ for the mark ORAL-B for
toothpaste and dental prophylaxis; and

No. 1,608,762⁸ for the mark ORAL-B in stylized
form for dental prophylaxis preparations,
namely, non-medicated mouthwash; medicated
mouth rinse preparation, topical flouride
gels for application to the teeth, dental
amalgam; dental floss, disposable trays for
topical application of dental medications;
and toothbrushes, denture brushes,
interdental brushes.

There is no evidence in the record, except the
application file of the opposed mark, regarding
applicant.

Analysis

Inasmuch as certified copies of opposer's
registrations are of record, there is no issue with
respect to opposer's priority. *King Candy Co., Inc. v.*
Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108
(CCPA 1974).

Our determination of likelihood of confusion under
Section 2(d) must be based on an analysis of all of the
probative facts in evidence that are relevant to the
factors bearing on the likelihood of confusion issue. *In*

⁷Registration No. 1,502,752, issued September 6, 1988, in International
Class 3. [Sections 8 and 15 affidavits accepted and acknowledged,
respectively.]

⁸Registration No. 1,608,762, issued August 7, 1990, in International
Classes 3, 5, 10 and 21, respectively. [Sections 8 and 15 affidavits
accepted and acknowledged, respectively.]

re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). See also *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

With respect to the goods of the parties, we observe that there is a substantial overlap in the goods identified in the application and in the pleaded registration. Further, applicant's additional identified dental products are closely related to the dental products identified in opposer's registrations. Thus, we conclude that the goods of the parties are either identical or closely related.

Further, both opposer's and applicant's identifications of goods are broadly worded, without any limitations as to channels of trade or classes of purchasers. We must presume that the goods of the applicant and opposer are sold in all of the normal channels of trade to all of the usual purchasers for

goods of the type identified. See *Canadian Imperial Bank v. Wells Fargo*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). In other words, we conclude that the channels of trade and class of purchasers of the parties' goods are the same.

Turning to the marks, we keep in mind that "when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Additionally, we find that opposer has demonstrated that its ORAL-B mark is famous for dental products, as shown by the sales and advertising figures submitted. This is a significant factor because famous marks enjoy a wide latitude of legal protection. "[T]he fame of a trademark may affect the likelihood purchasers will be confused inasmuch as less care may be taken in purchasing a product under a famous name." *Specialty Brands v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 6765, 223 USPQ 1281, 1284 (Fed. Cir. 1984). In addition, the fame of a mark magnifies the significance of the similarities between the marks which are compared. *Kenner Parker Toys Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22

USPQ2d 1453 (Fed. Cir. 1992), *cert. denied*, 113 S.Ct. 181 (1992).

Applicant's and registrant's marks both contain the term ORAL as the initial term in each mark. There is no question that ORAL has a suggestive significance for the dental products involved in this case.⁹

In opposer's marks, ORAL is followed by the letter B, which appears to be arbitrary in connection with opposer's products. In applicant's mark, ORAL is followed by the term, TECH, which is not an arbitrary term. TECH is likely to have a suggestive connotation that refers either to "technology," indicating that these products for oral hygiene and care employ technology in their design, or to "technician," as in "dental technician," the person who is likely to use the products identified by the mark.

In view of the suggestiveness of both parties' marks, it is not helpful to engage in an analysis of which element of each is the more suggestive. Rather, the marks must be compared in their entirety, giving weight to all of the elements.

⁹ We note that applicant has disclaimed the term ORAL in its mark. While this indicates that applicant may believe the term is merely descriptive, the disclaimer is not determinative of that question. In fact, opposer's marks contain no disclaimers, regardless of whether the

Although there are obvious differences in the marks because of the second elements of each, given the other factors discussed above, we find that these differences are not sufficient to avoid a likelihood of confusion. In particular, in view of the fame of opposer's ORAL-B marks; the identical and closely related goods involved; and the similarities between the parties' marks, consumers are likely to be confused as to source or sponsorship by applicant's ORAL TECH mark.

We do not suggest by this decision that opposer has exclusive rights to the term ORAL for dental products, and that any mark containing the element ORAL, used for dental products, would be likely to cause confusion with opposer's marks. However, to the extent that we have any doubts about our decision, we resolve those doubts in favor of the prior user and registrant. *W. R. Grace & Co. v. Herbert J. Meyer Industries, Inc.*, 190 USPQ 308 (TTAB 1976).

Decision: The opposition is sustained.

marks appear in stylized or typed form, or whether the marks include a hyphen between ORAL and the subsequent B or not.